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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,553	11/28/2003	Hajime Nakagawa	FS-F03214-01	8306
37398	7590	05/09/2006		
TAIYO CORPORATION 401 HOLLAND LANE #407 ALEXANDRIA, VA 22314			EXAMINER CHEA, THORL	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,553

Applicant(s)

NAKAGAWA ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20040401; 20051215.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: IDS dated 20050824; 20050706; 20031128.

DETAILED ACTION

1. This office action is responsive to the communication on February 10, 2006; claims 1-27 are pending in this instant application.
2. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tsukada et al (US Patent No. 2002/0058220) . The Tsukada et al as a whole especially the polymer on page 7, P-15 wherein $y = 33$, $z = 7$ and $T_g = 7^\circ\text{C}$; page 8 [0050] to [0051] and page 9, [0052] to [0057] which discloses the polymer having particle size not exceeding 500 nm and prepared in presence of photoinitiator of 0.05 to 5 % by weight of the monomer. The polymer P-15 is within the scope of the claimed invention. Therefore, the invention as claimed lacks novelty. Alternatively, it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the polymer

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disclosed in Tsukada et al with an expectation of achieving a material with good storage stability and good coating property.

6. Claims 1-2, 4-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukada et al (US Patent No. 2002/0058220).

Tsukada et al discloses a photothermographic material substantially as claimed. See Tsukada et al as a whole especially the polymer P-15 on page 7, the reducing agent on page 10, [0073]; organic silver salt including silver behenate on page 23, [0128]; the toning agent on page 29, [0207]; the antihalation dye such as copper phthalocyanine dye on page 30, [0217], the contrast increasing agent such as hydrazine on page 27, [0186] and silver halide on page 27, [0191]. See also page 39, claim 2 wherein the binder has glass transition temperature from -20 to 80°C .

Tsukada et al discloses a photothermographic material containing silver halide, silver salt of an organic acid, a reducing agent and the polymer P-15 wherein $y = 33$, $z = 7$ and $T_g = 7^{\circ}\text{C}$. The development accelerator may not specifically state therein, but it has been known in the art that the toning agent has been known as development accelerator. Therefore, it would have been obvious to the at the time the invention was made provide a photothermographic material containing the binder of formula P-15 in combination with the use of toning agent in the photothermographic material taught in Tsukada et al achieving a material with good storage stability and good coating property. The content of silver behenate in claim 4-5 is within the silver behenate disclosed on page 23, [0128]

7. Claims 2, 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukada et al (US Patent No. 2002/0058220) as applied to claims 1, 4-12 above, and further in view of Oya et al (US 2002/0098449). The hydrazine and phenol compound in claims 2-3 is known in

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Oya et al (US 2002/0098449) and Ohzeki (US 2002/0197570) as development accelerator. See '449 pages 89, claim 1, page 91, claim 7; and page 57, [0047]. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the hydrazine and phenol compound taught in Oya et al in the material of Tsukada et al (US Patent No. 2002/0058220) to achieve a material with good photographic property including sensitivity, fog and color tone, and thereby provide a material as claimed.

Response to Arguments

8. Applicant's arguments filed February 10, 2006 have been fully considered but they are not persuasive for the reason set forth in the above rejection. The Declaration under 37 CFR 1.132 on February 10, 2006 has been considered, but fails to overcome the rejection set forth above since it is irrelevant to Tsukada et al (US Patent No. 2002/0058220). Moreover, "(E)vidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C 102 rejections and thus cannot overcome a rejection so based. In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

Conclusion

9. Cited of interest: Arai (US Patent No. 6,013,410) discloses polymer latex having the scope of the claimed invention using binder in a photographic silver halide material. See column 7, formula (2) and compound PS-1 to PS-3.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *th*
September 29, 2005

Thorl Chea
Thorl Chea
Primary Examiner
Art Unit 1752